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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,533	02/08/2002	Yohei Ishikawa	P/1071-1520	5171

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EXAMINER

LEE, BENNY T

ART UNIT	PAPER NUMBER
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2817

DATE MAILED: 12/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

72533

Applicant(s)

Ishikawa  
Y. et al

Examiner

B. Lee

Group Art Unit

2817

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 8 February 2002
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 5-8 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 5-7; 8 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☒ The drawing(s) filed on 8 Feb 2002 is/are objected to by the Examiner.
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☒ received in Application No. (Series Code/Serial Number) 31981
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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The disclosure is objected to because of the following informalities: Page 1, lines 2, 3, note that updated status information (i.e. Patent number, issue date, etc) should be provided, if available. Pages 2-5, note that the "summary of the invention" should be rewritten to reflect the currently claimed invention (e.g. by deleting description of non-claimed embodiments). In the replacement paragraph to page 13, line 6, note that "writing resistance" should correctly be -- wiring resistance --. In the replacement paragraph to page 19, line 1, 3rd line from bottom, note that "FE010" should be -- FE010 --. Page 23, last line, note that uninitiated alterations improperly appear in the paragraph text and should be corrected by means of replacement paragraph..

Appropriate correction is required.

The disclosure is objected to because of the following informalities: Applicant's are advised that all labeled features/elements in the drawing figures should be correspondingly described in the specification. For example, reference labels (W<sub>1</sub>, 100) need description relative to Figures 3, 5, respectively and all the labeled features/elements of "figure 8" need explicit description in the specification.

Appropriate correction is required.

The drawings are objected to because in Fig 5, reference labels (~~L~~ ~~1~~) appear that they should correctly be (L<sub>1</sub>, L<sub>2</sub>) as per the specification description thereof. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5-7; 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the EP ('604) reference in view of Ishikawa et al ('485).

The EP reference in Fig. 17 thereof discloses a dielectric line (LN 303) comprised of a first slot between conductive lay<sup>er</sup> (321). Although not shown in Fig 17, a corresponding slot in an opposed conductive layer is provided (e.g. as exemplarily depicted in Fig. 1. Note that resonators (66,69) are coupled at ends of the dielectric line (LN 303) as well as an electronic device (305). A slot line (LN 304) is coupled to the resonators as well the dielectric line (LN 303).

However, the EP reference differs from the claimed invention in that mode conversion structures are lacking therein.

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Ishikawa et al (Fig. 1A) depicts a dielectric line structure including a slot line structure (6) for mounting an electronic component (15) and including mode conversion structures (7a, 7b) associated therewith.

Accordingly, it would have been obvious in view of the references, taken as a whole, to have added the mode conversion structures (7a, 7b), taught by Ishikawa et al, to the slot line (LN 304) of the EP reference. Such a modification would have imparted the advantageous benefit of better propagation due to the improved mode conversion to the slot line, thereby suggesting the obviousness of such a modification.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 5, 6; 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 6, 7 of U.S. Patent No. 6445255. Although the conflicting claims are not identical, they are not patentably distinct from each other because the more comprehensive claims of the cited patent contain at least the same limitations recited in the cited application claims and thus "anticipated" the cited application's claims.

Any inquiry concerning this communication should be directed to Benny Lee at telephone number (703) 308-4902.

BENNY T. LEE  
PRIMARY EXAMINER  
ART UNIT 2817

B LEE/pj

12/09/02